

REMARKS

Applicant respectfully requests reconsideration of this application, as amended herein. Claims 1-6 and 10-14 were pending in the application. In this amendment, Claim 1 has been amended and no claims have been canceled or added. Therefore, Claims 1-6 and 10-14 are pending in the application.

Double Patenting

The Examiner provisionally rejected Claims 1-6 under the judicially created doctrine of obviousness-type double patenting with respect to pending applications 10/393,346; 10/933,555; and 10/675,135. Applicant acknowledges the potential double patenting concern and will address the issue at an appropriate time.

The Rejections under 35 U.S.C. § 103

The Examiner has rejected Claims 1-6, 10, 11, 13 and 14 under 35 U.S.C. 103(a) as being unpatentable over Mucha (DE 195 03 027 A1) in view of Hilton et al. (EP 0 241 188 A1) and Friedank et al. (US 4,873,970). Applicant respectfully traverses the rejections.

Mucha teaches a respirator having a compressed air supply and a powered air supply/filter system with a sensor to sample the breathing air to the wearer. The Examiner asserts that essentially the differences between Mucha and the present invention are the lack of a regulator means in Mucha and the ability of the user to determine whether to breathe cleaned air or pressurized air. The Examiner further contends that Hilton et al. teaches the regulator means and Friedank et al. teaches the sensor means to generate a signal that will advise the wearer whether the gas emerging from the filter system has insufficient oxygen to be safely breathable. Actually, Friedank et al. teaches a warning device to indicate the end of useful life of a gas filter.

To establish a *prima facie* case of obviousness, there must be some teaching, suggestion, or motivation, either in the references themselves or in a convincing line of reasoning with knowledge generally available to one of ordinary skill in the art, to combine reference teachings. *See Manual of Patent Examining Procedure (MPEP) §2144; Ex parte Clapp*, 227 USPQ 972 (Bd. Pat. App. & Inter. 1985). There is no suggestion to combine the references. Nevertheless, the Examiner asserts that “it would have been obvious” to do so.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the

combination.” *Carella v. Starlight Archery and Pro Line Co.*, 804 F.2d 135, 140, 231 USPQ 644, 647 (Fed. Cir. 1986) (citing *ACS Hosp. Syss., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). “[T]he factual inquiry whether to combine references must be thorough and searching.” *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1351-52, 60 USPQ2d 1001, 1008 (Fed. Cir. 2001). It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to “[use] that which the inventor taught against its teacher.” *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). *In re Lee*, 277 F.3d 1338, 1343-44, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

In the present case, the Examiner has selected portions from three references to arrive at the present invention, in which, none of the references supply the motivation for any of the additional references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Independent Claim 1 recites a breathing apparatus having two sources of air including a pressurized cylinder of breathable air and powered, filtered ambient air. The breathing apparatus also includes a sensor to determine whether the filtered ambient air is safely breathable and means to switch to an alternate source of air and turn off the blower when the sensor provides a signal indicating that the air is not safely breathable. None of the cited references, separately or in combination, discloses or suggests a breathing apparatus having two sources of air in which one of the sources of air is a powered filtered respirator in which the user can determine which source of air to breathe and operation of the powered unit is controlled in conjunction with operation of a valve that controls the source of air to the user. As neither of Mucha, Hilton et al., nor Friedank et al. teaches or suggests the breathing apparatus as claimed, they are patentably distinguished.

Claims 2-6, 10, 11, 13, and 14 depend from Claim 1 and incorporates the same limitations as Claim 1, which, as described above, is patentably distinguished. Thus, Claims 2-6, 10, 11, 13, and 14 are, likewise, patentably distinguished.

Furthermore, as to Claims 11, the Examiner asserts that the control means in Mucha operates in an automatic manner responsive to signals from the sensors. This further highlights that the user of a Mucha device does not determine which source of air to breathe; in Mucha, the controller performs selection. According to the present invention, and as claimed in Claim 1, the user determines the source of air. Selection can be performed manually, automatically, or semi-automatically.

The Examiner has rejected Claim 12 under 35 U.S.C. 103(a) as being unpatentable over Mucha in view of Hilton et al. and Friedank et al. and further in view of Hübner (US 5,018,518). Applicant respectfully traverses the rejection.

As the Examiner is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Examiner may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. ... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) quoting *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

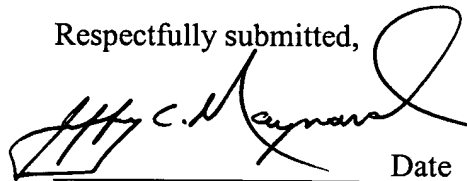
The Examiner has selected portions from four, unrelated references to arrive at the present invention. None of the references supplies the motivation for the additional references as proposed. Rather, the references are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the references do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

Furthermore, as described above, none of the references teaches a sensor means to detect particulate matter. The present invention describes and claims a breathing apparatus having two sources of air including a pressurized cylinder of breathable air and powered, filtered ambient air. The breathing apparatus also includes a sensor to determine whether the filter system is cleaning the air of particulate matter sufficiently, and means to switch to an alternate source of air when the sensor provides a signal indicating that the air is not clean. As the combination of references does not disclose all the elements of Claim 12, it is patentably distinguished.

CONCLUSION

Applicant has made a diligent effort to address the objections and rejections identified by the Examiner, and respectfully submits that the outstanding objections and rejections in the Office Action have been overcome. In view of the above amendments and remarks, all pending claims are believed to be patentable, and thus, the case is in condition for allowance. Accordingly, a Notice of Allowability is respectfully requested at the Examiner's earliest convenience. In the event that there is any question concerning this response, or the application in general, Applicant respectfully requests that the Examiner contact Applicant's attorney at the telephone number listed below so that additional changes may be discussed.

Respectfully submitted,

 10/4/06
Date

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